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27045	7590	03/17/2011	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			CHOUDHURY, AZIZUL Q	
			ART UNIT	PAPER NUMBER
			2453	
			NOTIFICATION DATE	DELIVERY MODE
			03/17/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/803,210

Applicant(s)

SKUBIC ET AL.

Examiner

AZIZUL CHOUDHURY

Art Unit

2453

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s) Mail Date _____

Detailed Action

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independent claims 1, 18, 27, 30 and 33 feature the claim limitation of locating the personal trusted device proximate the first location. However the specifications fail to describe the process of locating the personal trusted device being proximate the first location.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-11, 13-21, 23-27 and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudler et al (US Patent No: 7,302,585) in view of Wang (US Patent No: 5,917,913), hereafter referred to as Proudler and Wang, respectively.

1. With regards to claim 1, Proudler teaches through Wang, a method for digitally signing a document, comprising the steps of: receiving the document to be digitally signed at a first location, wherein the document is one selected from the group consisting of a text document, a contract, a letter and a sales receipt (*Proudler supports signing various document types, see at least column 6, lines 14-19, Proudler*); wherein the received document may be displayed in its entirety at the first location (*see column 4, lines 26-29 and column 6, lines 5-36, Proudler*); generating a representation of the document (*Proudler teaches display means on the host computer; see column 6, lines 5-36, Proudler*); forwarding the representation of the document to a personal trusted device, wherein the representation comprises one selected from the group consisting of document title, document number/id, and author/name id (*see at least column 9, lines 66-67, Proudler*); digitally signing the

representation of the document at the personal trusted device (*Proudler teaches signing the document via trusted component (personal trusted device); see column 6, lines 37-45, Proudler*); and locating the personal trusted device proximate the first location (*Proudler teaches the trusted component being near the host computer; see at least Figure 1, Proudler*).

While Proudler teaches a trusted component (personal trusted device), Proudler does not explicitly cite the claimed representation being sent to the trusted component (personal trusted device). In the same field of endeavor, Wang also teaches a portable authorization device, also called the PEAD (personal trusted device). Within Wang's disclosure, it is taught how encrypted forms of the data (representations) are sent to the PEAD; see column 7, lines 18-28, Wang. The encryption of data prior to transmission to a device enhances security. Therefore it would have been obvious to one skilled in the art, during the time of the invention to have combined the teachings of Proudler with those of Wang, to enhance security; see column 7, lines 18-20, Wang.

2. With regards to claims 2 and 24, Proudler teaches through Wang, the method wherein the first location comprises a trusted PC (*see column 6, lines 5-6 and lines 37-40, Proudler and column 4, lines 16-20, Wang*).
3. With regards to claim 3, Proudler teaches through Wang, the method further including the step authenticating an identity of the trusted PC by the personal trusted

device (*see column 6, lines 29-36, Proudler*).

4. With regards to claims 4 and 19, Proudler teaches through Wang, the method wherein the step of digitally signing further includes the step of entering a PIN into the personal trusted device (*see at least column 11, lines 5-10, Wang*).
5. With regards to claims 5 and 20, Proudler teaches through Wang, the method wherein the step of forwarding further comprises the steps of establishing a serial cable connection between the personal trusted device and the trusted PC (*see column 7, line 49 – column 8, line 7, Proudler and column 4, lines 33-39, Wang*).
6. With regards to claims 6 and 21, Proudler teaches through Wang, the method wherein the step of forwarding further comprises the steps of establishing an infrared connection between the personal trusted device and the trusted PC (*see column 7, line 49 – column 8, line 7, Proudler and column 4, lines 30-31, Wang*).
7. With regards to claim 8, Proudler teaches through Wang, the method further including the step of displaying the document at the trusted PC prior to digitally signing the representation (*see column 6, lines 43-45, Proudler and column 4, lines 40-43, Wang*).

8. With regards to claims 9 and 35, Proudler teaches through Wang, the method wherein the first location comprises a cryptography module within a PC (*see column 22, lines 47-50, Proudler and column 5, lines 1-18, Wang wherein it would be inherent within Wang's disclosure since the data sent from the first computer is already encrypted*).
9. With regards to claims 10, 23 and 34, Proudler teaches through Wang, the method further including the step of displaying the document at the PC in a browser associated with the cryptography module (*Proudler provides viewing software within the PC, see at least Figures 10a-10d, Proudler. In addition, it is also an inherent feature within Wang's disclosure since documents are displayed, see column 4, lines 16-18, Wang*).
10. With regards to claim 11, Proudler teaches through Wang, the method further including the step of forwarding the document from the first location to a trusted third party (*see at least Figure 2 and column 4, lines 13-27, Wang*).
11. With regards to claim 13, Proudler teaches through Wang, the method wherein the step of forwarding further comprises the steps of: forwarding the document to a server prior to generation of the representation of the document; forwarding the document and the representation of the document from the server to the trusted

party (*see at least Figure 2, column 4, lines 13-25 and column 13, lines 1-2, Wang*).

12. With regards to claim 14, Proudler teaches through Wang, the method wherein the step of forwarding the representation further comprises the step of streaming the representation and at least a portion of the document to the personal trusted device (*see at least column 6, lines 58-61 and column 8, lines 36-40, Proudler and column 12, line 65 – column 13, line 2 and column 11, lines 54-57, Wang*).

13. With regards to claims 15 and 31, Proudler teaches through Wang, the method further including the step of: selecting portions of the document to be streamed to the personal trusted device; and displaying the selected portions at the personal trusted device (*see at least column 6, lines 58-61 and column 8, lines 36-40, Proudler and column 4, lines 22-25 and column 4, lines 40-43, Wang*).

14. With regards to claims 16 and 32, Proudler teaches through Wang, the method further including the step of displaying only portions of the document contained within a buffer of the personal trusted device (*see column 8, lines 36-44, Proudler and Figure 6B along with column 4, lines 22-25 and column 11, lines 17-27, Wang*).

15. With regards to claim 17, Proudler teaches through Wang, the method further comprising the steps of: forwarding the document to the personal trusted device; generating a second representation of the document at the personal trusted device;

and comparing the representation with the second representation of the document
(*see at least column 5, lines 35-38, Proudler*).

16. With regards to claim 18, Proudler teaches through Wang, a method for digitally signing a document, comprising the steps of: locating a mobile terminal proximate a personal computer (*Proudler teaches the trusted component being near the host computer; see at least Figure 1, Proudler*); receiving the document to be digitally signed at the personal computer, wherein the document is one selected from the, group consisting of a text document, a contract, a letter and a sales receipt (*Proudler supports various document types; see at least column 6, lines 14-19, Proudler*); generating a hash from the document at the personal computer wherein the hash is representative of one selected from the group consisting of a document title, a document number/id, and an author/name id (*see at least column 9, lines 66-67, Proudler*); authenticating the personal computer from the mobile terminal (*see column 22, lines 39-47, Proudler*); forwarding the hash to the mobile terminal; displaying the document at the personal computer (*Proudler teaches display means on the host computer; see column 6, lines 5-36, Proudler*); displaying the hash at the mobile terminal; and digitally signing the hash of the document at the mobile terminal (*Proudler teaches signing the document via trusted component (mobile terminal); see column 6, lines 37-45, Proudler*).

While Proudler teaches a trusted component (personal trusted device), Proudler does not explicitly cite the claimed representation being sent to the trusted

component (personal trusted device). In the same field of endeavor, Wang also teaches a portable authorization device, also called the PEAD (personal trusted device). Within Wang's disclosure, it is taught how encrypted forms of the data (representations) are sent to the PEAD; see column 7, lines 18-28, Wang. The encryption of data prior to transmission to a device enhances security. Therefore it would have been obvious to one skilled in the art, during the time of the invention to have combined the teachings of Proudler with those of Wang, to enhance security; see column 7, lines 18-20, Wang.

17. With regards to claim 25, Proudler teaches through Wang, the method wherein the step of generating comprises the step of generating the hash from the document at a cryptography module in the personal computer *(see column 22, lines 47-50, Proudler and column 5, lines 1-18, Wang wherein it would be inherent within Wang's disclosure since the data sent from the first computer is already encrypted).*
18. With regards to claim 26, Proudler teaches through Wang, the method further comprising the steps of: forwarding the document to the personal trusted device; generating a second hash of the document at the personal trusted device; and comparing the hash with the second representation of the document *(see at least column 5, lines 35-38, Proudler).*

19. With regards to claim 27, Proudler teaches through Wang, a method for digitally signing a document, comprising the steps of: locating a mobile terminal proximate a personal computer (*Proudler teaches the trusted component being near the host computer; see at least Figure 1, Proudler*); receiving the document to be digitally signed at a personal computer, wherein the document is one selected from the group consisting of a text document, a contract, a letter and a sales receipt (*Proudler supports various document types; see at least column 6, lines 14-19, Proudler*); wherein the received document may be displayed in its entirety at the personal computer (*see column 4, lines 26-29 and column 6, lines 5-36, Proudler*); forwarding the document to a server; generating a hash from the document at the server wherein the hash is representative of one selected from the group consisting of a document title, a document number/id, and an author/name id (*see at least column 9, lines 66-67, Proudler*); forwarding the hash and the document from the server to a trusted third party from the server (*see column 9, lines 33-37*); forwarding the hash to a mobile terminal from the trusted third party; and digitally signing the hash of the document at the mobile terminal (*Proudler teaches signing the document via trusted component (mobile terminal); see column 6, lines 37-45, Proudler*).

While Proudler teaches a trusted component (personal trusted device), Proudler does not explicitly cite the claimed representation being sent to the trusted component (personal trusted device). In the same field of endeavor, Wang also teaches a portable authorization device, also called the PEAD (personal trusted device). Within Wang's disclosure, it is taught how encrypted forms of the data

(representations) are sent to the PEAD; see column 7, lines 18-28, Wang. The encryption of data prior to transmission to a device enhances security. Therefore it would have been obvious to one skilled in the art, during the time of the invention to have combined the teachings of Proudler with those of Wang, to enhance security; see column 7, lines 18-20, Wang.

20. With regards to claim 29, Proudler teaches through Wang, the method further including the step of requesting a digital signature at the PC (*see column 11, line 65 – column 12, line 29, Proudler*).
21. With regards to claim 30, Proudler teaches through Wang, a method for digitally signing a document, comprising the steps of: locating a mobile terminal proximate a personal computer (*Proudler teaches the trusted component being near the host computer; see at least Figure 1, Proudler*); receiving the document to be digitally signed at the personal computer wherein the document is one selected from the, group consisting of a text document, a contract, a letter and a sales receipt (*Proudler supports various document types; see at least column 6, lines 14-19, Proudler*); wherein the received document may be displayed in its entirety at the personal computer (*see column 4, lines 26-29 and column 6, lines 5-36, Proudler*); generating a hash from the document at the personal computer wherein the hash is representative of one selected from the group consisting of a document title, a document number/id, and an author/name id (*see at least column 9, lines 66-67,*

Proudler); streaming the hash and at least a portion of the document to a mobile terminal (see at least column 6, lines 58-61 and column 8, lines 36-40, *Proudler* and column 12, line 65 – column 13, line 2 and column 11, lines 54-57, *Wang*); and digitally signing the hash at the mobile terminal (*Proudler teaches signing the document via trusted component (mobile terminal)*; see column 6, lines 37-45, *Proudler*).

While Proudler teaches a trusted component (personal trusted device), Proudler does not explicitly cite the claimed representation being sent to the trusted component (personal trusted device). In the same field of endeavor, Wang also teaches a portable authorization device, also called the PEAD (personal trusted device). Within Wang's disclosure, it is taught how encrypted forms of the data (representations) are sent to the PEAD; see column 7, lines 18-28, Wang. The encryption of data prior to transmission to a device enhances security. Therefore it would have been obvious to one skilled in the art, during the time of the invention to have combined the teachings of Proudler with those of Wang, to enhance security; see column 7, lines 18-20, Wang.

22. With regards to claim 33, Proudler teaches through Wang, a system for digitally signing a document, comprising: a personal computer for receiving and displaying the document to be digitally signed and enabling generation of a hash of the document (*Proudler teaches signing the document*; see column 6, lines 37-45, *Proudler*); and a personal trusted device located proximate the personal computer

(Proudler teaches the trusted component being near the host computer; see at least Figure 1, Proudler), the personal trusted device adapted to display the hash and for enabling digital signing of the hash, wherein the document is one selected from the group consisting of a text document, a contract, a letter and a sales receipt (Proudler supports various document types; see at least column 6, lines 14-19, Proudler) and wherein the hash is representative of one selected from the, group consisting of a document title, a document number/id, and an author/name id (see at least column 9, lines 66-67, Proudler).

While Proudler teaches a trusted component (personal trusted device), Proudler does not explicitly cite the claimed representation being sent to the trusted component (personal trusted device). In the same field of endeavor, Wang also teaches a portable authorization device, also called the PEAD (personal trusted device). Within Wang's disclosure, it is taught how encrypted forms of the data (representations) are sent to the PEAD; see column 7, lines 18-28, Wang. The encryption of data prior to transmission to a device enhances security. Therefore it would have been obvious to one skilled in the art, during the time of the invention to have combined the teachings of Proudler with those of Wang, to enhance security; see column 7, lines 18-20, Wang.

23. With regards to claim 36, Proudler teaches through Wang, the system further including: a server for generating the hash from the document; and a trusted party for providing the hash to the personal trusted device *(see at least Figure 2 and*

column 4, lines 16-20, Wang).

24. With regards to claim 37, Proudler teaches through Wang, the system wherein the personal computer streams the hash and at least a portion of the document to the mobile terminal (*see at least column 6, lines 58-61 and column 8, lines 36-40, Proudler and column 12, line 65 – column 13, line 2 and column 11, lines 54-57, Wang*).

25. The obviousness motivation applied to independent claims 1, 18, 27, 30, and 33 are applicable to their respective dependent claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 12, 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudler et al (US Patent No: 7,302,585) in view of Wang (US Patent No: 5,917,913) and in further view of Moore et al (US Patent No: 7,257,836), hereafter referred to as Proudler, Wang and Moore, respectively.

26. With regards to claims 7 and 22, Proudler teaches through Wang and Moore, the method wherein the step of forwarding further comprises the steps of establishing a Bluetooth connection between the personal trusted device and the trusted PC

While Proudler teaches a variety of connections (column 7, line 49 - column 8, line 7, Proudler) and Wang teaches wireless RF connections (column 9, lines 25-26, Wang), neither explicitly disclose the use of Bluetooth. Within the same field of endeavor, Moore teaches the secure connection of devices; see column 2, lines 4-7, Moore. Within Moore's disclosure it is supported how devices can be securely and wirelessly connected, including through Bluetooth; see column 7, lines 36-43, Moore. By securely connecting devices, eavesdropping is prevented. Therefore it would have been obvious to one skilled in the art, to have combined the teachings of Proudler and Wang with those of Moore, to prevent eavesdropping of the communication; see column 1, lines 30-36, Moore.

27. With regards to claims 12 and 28, Proudler teaches through Wang and Moore, the method wherein the step of forwarding further comprises forwarding the documents from the first location to the trusted third party using SSL/TLS.

While Proudler teaches a variety of secure connections (column 7, line 49 - column 8, line 7, Proudler) and Wang teaches wireless RF connections (column 9, lines 25-26, Wang), neither explicitly disclose the use of SSL/TLS. Within the same field of endeavor, Moore teaches the secure connection of devices; see column 2, lines 4-7, Moore. Within Moore's disclosure it is supported how devices can be

securely and wirelessly connected, including through TLS and SSL; see column 2, lines 12-18, and column 11, lines 42-45, Moore. By securely connecting devices, eavesdropping is prevented. Therefore it would have been obvious to one skilled in the art, to have combined the teachings of Proudler and Wang with those of Moore, to prevent eavesdropping of the communication; see column 1, lines 30-36, Moore.

Response to Arguments

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection. In lieu of the latest claim amendments, a new search has been performed and a new grounds of rejection has been provided.

Based on the clarified claims, the new Proudler art has been introduced. Proudler teaches a trusted component, separate from the host computer, which enables the digital signing of documents. Proudler also supports various formats of documents including contracts and textual documents. In addition, Moore has been introduced to teach how separate devices that are connected can communicate securely using Bluetooth and SSL/TLS.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele can be reached on (571) 272-7288. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./
Examiner, Art Unit 2453

/Krista M. Zele/
Supervisory Patent Examiner, Art Unit 2453